

### **Remarks**

Claims 1-16 are pending in the above-identified application. By this amendment, Independent claims 9 and 16 are amended. The amendments to the claims are supported by the application as originally filed, and do not introduce new matter. Further, the amendments to the claims are for clarification purposes only and not intended to limit the scope of the claims in any way. Accordingly, entry of the amendments to claims 9 and 16 is respectfully requested.

### **Claim Rejections - 35 U.S.C. §101**

The Office Action rejects claims 9-12, 14, and 15, under 35 U.S.C. § 101 as reciting non-functional descriptive material that do not define patentable subject matter and do not require the technical or useful arts. Office Action, p. 2. As noted in *Ex parte Lundgren*, “there is currently no judicially recognized separate ‘technological arts’ test to determine patent eligible subject matter under § 101.” *Ex parte Lundgren*, Appeal No. 2003-2088 p. 10 (Bd. Pat. App. & Int. 2005), at <http://www.uspto.gov/web/offices/dcom/bpai/prec/2003-2088.pdf>. Moreover, the Federal Circuit has ruled that in determining patentable subject matter under 35 U.S.C § 101 the relevant test is whether the invention produces a useful, concrete and tangible result. *State Street Bank*, 47 U.S.P.Q. 2d 1596 (Fed. Cir. 1998). Claim 9 recites a “program product” for including a document in an index. The resultant index is a useful, concrete and tangible result.

With respect to claims 9-12, 14, and 15, the Examiner also asserts “that ‘machine-readable medium’ can be interpreted as including a signal and/or carrier wave, which are not tangible media.” The Applicant respectfully disagrees with the Examiner. Though “machine-readable medium” may be interpreted as including a signal or carrier wave, such an interpretation does not preclude patentability under 35 U.S.C. § 101. A signal or carrier wave constitutes a useful, concrete and tangible result under the aforementioned *State Street Bank* decision.

The Examiner further asserts claim 16 is “software per se and is not tangibly embodied to a computer system,” therefore not requiring the technical or useful arts. Office Action, p. 3. The Examiner asserts that the rejection to this claim may be overcome if an inference to some form of hardware is claimed. Applicant notes that “there is currently no

judicially recognized separate ‘technological arts’ test to determine patent eligible subject matter under § 101.” *Ex parte Lundgren* at 10.

Additionally, the Examiner asserts that claim 16 does not satisfy the useful, concrete and tangible result test of State Street Bank. The Applicant respectfully disagrees. Claim 16 describes a system for indexing a document. The resultant index is a useful, concrete, and tangible result.

However, despite the comments above, to facilitate prosecution on the merits, claims 9 and 16 are amended to recite “a computerized machine-readable medium” and “a computer system,” respectively.

In light of the abovementioned amendments and remarks, reconsideration of the rejection of claims 9-12 and 14-16 under 35 U.S.C. §101 is respectfully requested.

#### **Rejection based on 35 U.S.C. §103**

Claims 1-12 and 14-16 are rejected under 35 U.S.C. §103(a) as being obvious in view of U.S. Patent 6,112,203 to Bharat et al. (“Bharat”). Reconsideration of the application in light of the remarks below is respectfully requested.

In order to establish a prima facie case of obviousness, the prior art references must teach or suggest all of the claim limitations. M.P.E.P. §706.02(j). The Office Action has not met that burden here.

Among the limitations of independent claim 1, which are neither shown nor suggested in the art of record are:

A method for including a document in an index in a hyperlinked environment, comprising the acts of: ... retrieving anchortext associated with at least one of the hyperlinks;

Among the limitations of independent claim 9, which are neither shown nor suggested in the art of record are:

A program product embedded in a computerized machine-readable medium for including a document in an index in a hyperlinked environment, comprising the instructions for: ... retrieving anchortext associated with each hyperlink;

Among the limitations of independent claim 16, which are neither shown nor suggested in the art of record are:

A computer system for indexing a document in a hyperlinked environment, comprising: ... a module for retrieving anchortext associated with each hyperlink;

The Examiner concedes that Bharat does not teach the limitations of the present invention, however, the Examiner asserts that “those of ordinary skill in the art are well aware that anchortext can simply be the URL itself.” Office Action p. 8. The Applicant requests that the Examiner set forth a reference which shows such a teaching or that the Examiner submit an Examiner's affidavit indicating that such knowledge is known by one of ordinary skill in the art at the time of the invention so that the Applicant has the opportunity to rebut such an assertion. See M.P.E.P. § 2144.03.

Further, the Examiner asserts that Bharat discusses anchortext and references Col. 3, lines 3-15 of Bharat, which recites “[t]he score is a weighted sum of the number of directed edges to and from a node and the number of unique sub-strings of the URL that match a query term.” However, Bharat does not teach the retrieval nor parsing of anchortext as is claimed.

The Examiner attempts to equate unique sub-strings of a URL with anchortext. Despite the Examiner's recognition that Bharat neither “explicitly or specifically use[s] the word anchortext,” the Examiner asserts that “substrings of a URL are examples of tokens in anchortext.” Office Action, p. 8. As noted in the present specification (page 2, lines 11-18), anchortext is the text associated with a URL, but not the URL itself.

Bharat does not make any use of anchortext and does all processing on a URL. See Bharat, Col. 5, lines 52-56. Anchortext associated with a hyperlink need not have any relation to the URL specified. As a URL is a predetermined address of a web page, the processing and sub-string parsing Bharat performs is confined to the address which a web page designer is forced to use when providing a hyperlink to a web page. See, Bharat Col. 3, lines 10-15. On the other hand, the present invention retrieves and performs processing and parsing on the nearly limitless combination of words available, thereby providing an analysis of a unique hyperlink component not disclosed or utilized in Bharat.

The Examiner asserts that “if the web site for United Airlines was simply referenced as the URL <www.UAL.com> on a web site, then <www.UAL.com> would be the Anchortext....” Office Action, p. 8. The Examiner further asserts that “anchortext can simply be the URL itself.” Office Action, p.8. The applicant respectfully disagrees. In order for <www.UAL.com> to serve as anchortext for the URL “www.UAL.com”, a hyperlink must be constructed specifying

“www.UAL.com” as the URL and <www.UAL.com> as the anchortext associated with the URL. Furthermore, in order to provide access to the United Airlines web site, a hyperlink constructed must use “www.UAL.com” as the URL. Alternatively, the anchortext associated with the URL “www.UAL.com” may be any combination of characters. Claims 1, 9, and 16 recite “retrieving anchortext” and not “retrieving a URL.”

Bharat neither teaches nor suggests the retrieval or use of anchortext associated with a hyperlink as is claimed. It thus follows that absent retrieval of anchortext, Bharat cannot teach or suggest the claimed limitation of parsing anchortext into one or more tokens. Bharat merely discloses the parsing of a URL associated with a hyperlink. Bharat and the present invention retrieve entirely distinct components of a hyperlink, serving entirely distinct functions. Therefore, Bharat neither teaches nor suggests the above referenced limitations of independent claims 1, 9 or 16. Thus, it is asserted that independent claims 1, 9 and 16 are patentable over Bharat.

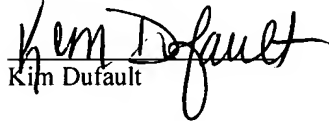
Dependent claims 2-8, 10-12 and 14-15 include the above referenced limitations of independent claims 1 and 9, respectively, and include additional recitations which, when combined with independent claims 1 and 9 are also neither disclosed nor suggested in the art of record. It is asserted that these claims are patentable as well.

Reconsideration of the rejection of claims 1-12 and 14-16 under 35 U.S.C. §103 is respectfully requested in light of the remarks above.

It is asserted that the present communication places the application in a form for allowance or in better condition for appeal. Entry is earnestly solicited.

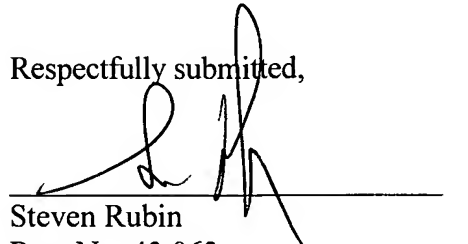
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I hereby certify that the correspondence attached herewith is being deposited this date with the U.S. Postal Service as First Class Mail with sufficient postage addressed to Mail Stop: Amendments, Commissioner for Patents, Box 1450, Alexandria, VA 22313-1450.

  
Kim Dufault

October 24, 2005  
Date

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